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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,702	09/15/2003	John Scharf	DMD116	1031

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IRVINE, CA 92604

EXAMINER

BERHANU, ETSUB D

ART UNIT	PAPER NUMBER
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3768

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,702

Applicant(s)

SCHARF ET AL.

Examiner

Etsub D. Berhanu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 62-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenheimer'771 (USPN 5,497,771).

Figure 5 of Rosenheimer'771 discloses a system capable of monitoring the oxygen saturation of a fetus (see title), the system comprising: a housing (29) comprising a base integrally formed with an enclosure for receiving a plurality of wires (27 and 43) and a curved border area integrally formed with the base and extending out from the base wherein the curved border area is defined by a plurality of sloping sides; at least one light emitting source (10 and 11) positioned within the base and at least one detector (18) positioned within the base, wherein the detector is in data communication with an oximeter (col. 3, line 64 – col. 4, line 2); a divider (28) between the light emitting source and the detector; and means for suctioning the system to a fetus (col. 4, line 66 – col. 5, line 4). It is noted that while the system of Rosenheimer'771 is intended to suction to the scalp of a fetus, that the system is not structurally distinguishable from the invention disclosed in claims 62-65 of the current application. It is further noted that the system of Rosenheimer'771 is capable of suctioning to the chin of a fetus.

Claim Rejections - 35 USC § 103

3. Claims 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jobsis et al.'930 (previously cited), further in view of Blank et al.'484 (US Pub. No. 2003/0069484), further in view of Wiesmann et al.'550 (previously cited).

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Figure 1 of Jobsis et al.'930 discloses a system capable of monitoring the oxygenation state of blood in a tissue (col. 2, lines 59-65), the system comprising: a housing (65) comprising a base integrally formed with an enclosure for receiving a plurality of wires (80 and 82) and a curved border area integrally formed with the base and extending out from the base wherein the curved border area is defined by a plurality of sloping sides (see also col. 9, lines 13-23); at least one light emitting source (80') positioned within the base and at least one detector (82') positioned within the base; and Figure 6 indicates a divider (86) between the light emitting source and the detector. Figure 3 indicates that the detector is in data communication with a monitor (85). It is noted that because the monitor detects the oxygenation state of blood in a tissue, that the monitor is an oximeter. It is further noted that the system disclosed by Jobsis et al.'930 is capable of being positioned around the chin region of a subject using the straps (60) shown in Figure 1.

Jobsis et al.'930 discloses all of the elements of the current invention, as discussed above, except for the housing being capable of suctioning onto a patient's chin region. Blank et al.'484 teaches that straps and suctioning means are alternate equivalent attachment means (page 6, section [0058]). It would have been within the skill of the art to substitute suctioning attachment means for the strap attachments of Jobsis et al.'930 since Blank et al.'484 teaches that they are alternate equivalents and it has generally been held within the skill of the art to substitute alternate equivalent expedients.

Jobsis et al.'930 further in view of Blank et al.'484 discloses all the elements of the current invention, as discussed above, except for the apparatus being attached to a helmet.

Wiesmann et al.'550 teaches incorporating an oxygen sensor system into an athlete's helmet in order to monitor the exertion of the athlete during competition (col. 15, lines 15-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Jobsis et al.'930 further in view of Blank et al.'484 to be attached to a helmet, as taught by

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Wiesmann et al.'550, since the helmet would allow the exertion of an athlete during competition to be monitored.

Response to Arguments

4. Applicant's arguments with respect to the newly added claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hulka'197 (USPN 4,537,197) discloses a fetal oxygen monitor comprising a light emitting source and detector in communication with an oximeter monitor, and capable of suctioning to the scalp of a fetus.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etsub D. Berhanu whose telephone number is 571.272.6563. The examiner can normally be reached on Monday - Friday (Every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on (571)272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDB

ERIC F. WINAKUR
PRIMARY EXAMINER

